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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/684,869

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David Allison Bennett

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KHORSANDI PATENT LAW GROUP, A.L.C.

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EXAMINER

PLUCINSKI, JAMISUE A

ART UNIT

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3629

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/684,869	Applicant(s) BENNETT ET AL.	
	Examiner JAMISUE A. PLUCINSKI	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 64-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 64-79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20080918</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 64-79 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. An invention, which is eligible for patenting under 35 U.S.C. § 101, is in the “useful arts” when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a “useful, concrete and tangible result.” The test for practical application as applied by the examiner involves the determination of the following factors:

- (a) “Useful” - The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished.

Applying utility case law the examiner will note that:

- i. the utility need not be expressly recited in the claims, rather it may be inferred.
- ii. If the utility is not asserted in the written description, then it must be well established.

- (b) “Tangible” - Applying *In re Warmerdan*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical

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construct claimed, such as a disembodied data structure and method of making it.

If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. § 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

- (c) “Concrete” - Another consideration is whether the invention produces a “concrete” result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

4. In Claims 64-79 the claims are directed towards a system, without any structural claim limitations. The claims recite a system management computer that is programmed to perform a function, and outlines the functions; however the claims fail to recite any actual structure of the system, such as a processor, computers or servers. Therefore causing the claims to not be tangible.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 64-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara et al.(6,233,568) in view of InterShipper (Newsbytes Article, Internet Update) UPS® On Call Air Pickup (www.apps.ups.com), UPS® Service Guide (www.ups.com) and FedEx® Services (www.fedex.com).

8. With respect to Claim 64: Kara discloses the use of a shipping management computer system (see abstract) for:

- a. Receiving information from a user such as a set of package specifications (Figure 8, Box 802) and shipping information (See Figure 8);
- b. Determining multiple shipping rates (first and second) for a first carrier (Figure 8, Boxes 807 and 808);
- c. Determining multiple shipping rates (third and fourth) for a second carrier (Figure 8, Boxes 807 and 808);
- d. Receiving a request from a user to ship a package using one of the services by one of the carriers (See Figure 8, Column 5, lines 56-67);
- e. Facilitating the delivery of the package (Column 6, lines 1-6).

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9. Kara disclose the use of calculating and displaying rates for specific services, for multiple carriers, but fails to disclose the simultaneous display of rates for each carrier that includes rates of different services (Column 11, lines 1-13). Intershipper is an internet, online website, where internet users can enter origin, destination, package weight and dimensions and will be displayed every method possible that you can use to ship your package for all major shippers (See Internet Update Article Page 1, Paragraphs 1-3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Nicholls and Kara to display every method possible to ship a package, as disclosed by InterShipper, in order to find the cheapest shipping rate (See Page 1).

10. Kara discloses receiving shipping information, however fails to disclose the receiving the shipping date from the user. UPS discloses its on-call pick up which allows a user to schedule a pick-up with UPS, therefore receiving a shipping date, the examiner considers the day the carrier picks up the package is the shipping date, since it is out of the user's hands at that time and the shipping process is started (see Page 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kara, to have the ability to schedule a shipping date by the user, as taught by UPS. Using a known technique of a user inputting the shipping date, by scheduling a pick-up time, would have been obvious to one of ordinary skill in the art. (See KSR [127 S Ct. at 1739] "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.").

11. With respect to Claims 65-67: See Figure 8, Box 807 and 808.

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12. Claims 68-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara, InterShipper, UPS® On Call Air Pickup, UPS® Service Guide and FedEx® as applied to claim 64 above, and further in view of Barnett et al. (6,369,840).

13. With respect to Claims 68-79: Kara discloses the use of a shipping management computer system (see abstract) for:

- f. Receiving a set of package specifications (Figure 8, Box 802) and shipping information (Figure 8);
- g. Determining multiple shipping rates (first and second) for a first carrier (Figure 8, Boxes 807 and 808) ;
- h. Determining multiple shipping rates (third and fourth) for a second carrier (Figure 8, Boxes 807 and 808) ;
- i. Receiving a request from a user to ship a package using one of the services by one of the carriers (See Figure 8, Column 5, lines 56-67) ;
- j. Facilitating the delivery of the package (Column 6, lines 1-6).

14. Kara disclose the use of calculating and displaying rates for specific services, for multiple carriers, but fails to disclose the simultaneous display of rates for each carrier that includes rates of different services (Column 11, lines 1-13). InterShipper is an internet, online website, where internet users can enter origin, destination, package weight and dimensions and will be displayed every method possible that you can use to ship your package for all major shippers (See Internet Update Article Page 1, Paragraphs 1-3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Nicholls and Kara to display every

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method possible to ship a package, as disclosed by InterShipper, in order to find the cheapest shipping rate (See Page 1).

15. Kara discloses receiving shipping information, however fails to disclose the receiving the shipping date from the user. UPS discloses its on-call pick up which allows a user to schedule a pick-up with UPS, therefore receiving a shipping date, the examiner considers the day the carrier picks up the package is the shipping date, since it is out of the user's hands at that time and the shipping process is started (see Page 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kara, to have the ability to schedule a shipping date by the user, as taught by UPS. Using a known technique of a user inputting the shipping date, by scheduling a pick-up time, would have been obvious to one of ordinary skill in the art. (See KSR [127 S Ct. at 1739] "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.").

16. Kara discloses a display where the rates of each carrier are displayed adjacent to the selected services (See Figures 8A). However Kara does not specifically disclose the rates being calculated with respect to day and time, according to the shipping date. Both UPS® and FedEx® disclose specific services where they are guaranteed delivery by a certain time in the day and disclose scheduling a pick-up. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the time sensitive "urgency" services, as disclosed by FedEx® and UPS®, in order to ship thing and compete with a time advantage using guaranteed delivery times and to reduce costs, when delivery time is not of importance. (See Fed Ex Page 1). Kara, InterShipper, UPS® and FedEx® fail to disclose the use of a simultaneous display with shows the date and time of services Barnet discloses the use of a calendar which can

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be used for online purchasing of services (column 2, lines 63-67), where there is a graphical representation of date on one axis and time on another (See Figure 9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the display of rates of Kara, Intershipper, UPS® and FedEx® with respect to day and time, include the day and time, as disclosed by Barnett, in order to provide a single integrated display that allows a user to order or purchase a system based on the calendar day and time (See Barnett, column 2).

Response to Arguments

17. Applicant's arguments filed 9/18/08 have been fully considered but they are not persuasive.

18. With respect to Applicant's Argument A, that none of the references of record disclose determining a shipping rate in response to receiving a shipping date, identifying days and times by which a package would be delivered according to a shipping date: As stated in the office action above, UPS has a service which allows the use of scheduling a pick-up of a package. When a pick up is scheduled, and the user enters in the scheduled pick-up date, then the user is submitting a shipping date. The applicant is arguing the combination of Kara and the UPS references stated that it is not obvious to one of ordinary skill in the art to combine the references because even if combined, Kara only calculates for an urgency and does not calculate for a shipping date, and asserts that there is no disclosure in either reference that teaches or suggests the combination of limitations claimed by claim 64, regarding receiving a set of package specifications and an indication of a shipping date and then in response to receiving the set of package specifications and the indication of the shipping date determining various shipping rates

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for various delivery services by various carriers. The examiner agrees that there is no one reference which teaches this, hence why a 103 rejection is applied. Kara discloses receiving a set of parcel specifications and determining the shipping cost. UPS discloses scheduling a shipping, and discloses calculating rates based on things like shipping date (schedule a pick up), therefore the combination of references would provide claims as recited. The applicant also appears to be arguing the combinations based on only Kara and UPS, and fails to argue the rejection as applied, i.e. with the references Intershipper and Barnett. The Applicant argued that Kara and UPS On Class would not provide the limitation of Claim 74, however the claim limitation of 74 of identifying days, would be taught by a combination of Kara, UPS, FedEx, Intershipper and Barnett.

19. With respect to Applicant's Argument B: Neither InterShipper nor Kara disclose a simultaneous display of rates: The applicant has stated a simultaneous display of rates is inferred from InterShipper, and this conclusion is unsupported. InterShipper states that the service will "return every method possible that you can use to ship your package and arrange the results in cost order and color code the results by approximate transit time". The InterShipper article may not explicitly disclose that the results are displayed on a computer screen, however InterShipper discloses all the information being given at one time. Kara discloses a computer display where multiple information is given for one package for a user to make a choice, the display is a simultaneous display of rates for each carrier, yet in order for the user to receive a display for each service, the user must click on each service and calculate. InterShipper discloses some sort of display, whether it be in terms of a computer screen, or a piece of paper, the user is provided with all the information at one time. Therefore the combination of references, Kara and

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InterShipper, would provide the simultaneous computer display of all the rates for all the carries for each service.

20. With respect to Applicant's Argument C: The argument is moot in view of the rejection above. The examiner has changed the rejection to reflect the shipping date of Claim 64 so that the rejection reflects the added claim limitations.

21. With respect to Applicant's Argument B, that none of the references of recode disclose generating a simultaneous display of delivery days for delivery of a package by multiple delivery services by multiple carriers: It is asserted that there is no disclosure in any of the references which would include the identification of "...a [particular] day on which a [particular] carrier would deliver a particular package to a particular destination according to a particular shipping date, if [the particular] carrier were to deliver said package to said destination via a [particular] delivery service.." It is agreed that there is no one reference which teaches the entire limitation, however it is the combination of all the references which provide this limitation. Kara and InterShipper disclose calculating and displaying simultaneous display of rates of each carrier of each service, the UPS and FedEx references discloses determining dates and times for shipments. Barnett discloses a calendaring system which displays things on a time and date basis. Even though the Calendaring system of Barnett is used for a different reason, Barnett discloses the calendar can be used for scheduling of services and what services or available. Therefore the determination of date and time is done by the UPS and the FedEx references, Barnett is simply displaying them in a certain fashion. It is the examiner's position that the combination of references discloses the claim limitations as recited.

22. The rejections stand as stated above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMISUE A. PLUCINSKI whose telephone number is (571)272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamisue A. Plucinski/
Primary Examiner, Art Unit 3629